



Paper No. 8

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APR 19 2002

In re Application of	:	OFFICE OF PETITIONS
Mosuvan Kuppusamy,	:	
Vellimedu Kannappa Srinivas,	:	DECISION REFUSING STATUS
Subhra Lahiri, Krishna Ella and	:	UNDER 37 C.F.R. §1.47(a)
Ghan Shyam Khatri	:	
Application No. 09/882,509	:	
Filed: June 15, 2001	:	
Title: RECOMBINANT STREPTOKINASE	:	

This is in response to the petition under 37 C.F.R. §1.47(a), filed January 28, 2002 (certificate of mailing October 25, 2001).

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Extensions of time under §1.136 are available. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on June 15, 2001, without an executed oath or declaration, but named Mosuvan Kuppusamy, Vellimedu Kannappa Srinivas, Subhra Lahiri, Krishna Ella and Ghan Shyam Khatri as joint inventors. Accordingly, on August 16, 2001, applicants were mailed a "Notice to File Missing Parts of Application," requiring *inter alia* an executed oath or declaration, and payment of the surcharge for late filing under §1.16(e). This Notice set a two-month period for reply, with extensions of time obtainable under §1.36(a).

In response, applicants filed the instant petition, made timely by an accompanying petition for a one-month extension of time. Also enclosed was a declaration signed by inventors Kuppusamy, Srinivas, Lahiri and Ella on behalf of themselves and on behalf of non-signing inventor Khatri; and payment of both the petition fee and the late surcharge. Applicants assert that status under §1.47(a) is proper because joint inventor Khatri refuses to join in the application. In support thereof, applicants submitted *inter alia* a copy of a cover letter explaining that, "due to certain professional related obligations," Dr. Khatri was refusing to sign the declaration.

Having reviewed the evidence, it is concluded that the petition under §1.47(a) is not grantable. A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor

either cannot be reached or found after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings and oath or declaration); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Petitioner has not shown that inventor Khatri by his conduct refuses to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that the combined declaration and power of attorney were sent to inventor Khatri. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to the non-signing inventor and he refused to sign. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Furthermore, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Deficiencies:

1. The petition does not show that inventor Khatri refused to join in the application after having been presented with all of the application papers; and
2. The petition suggests that inventor Khatri has stated that he refuses to join in the application, but does not include a statement of facts from a person or persons to whom the oral refusals were made.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to
Petitions Attorney Nancy Johnson at (703) 305-0309.

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